

### **IN THE SPECIFICATION**

Page 1, line 5, delete "continuation" and replace with --continuation-in-part--.

### **REMARKS**

This is a full and timely response to the final Office Action of March 9, 1999.

Reexamination, reconsideration, and allowance of the application and all presently pending claims are respectfully requested.

Upon entry of this Second Response, claims 1-21 and 23-49 remain pending in this application. The specification has been amended to correctly claim priority to various other earlier filed U.S. patent applications as a continuation-in-part application rather than as a continuation application. This amendment corrects for a recently discovered clerical error and, therefore, places the present application in a better condition for appeal or publication. Accordingly, entry of the foregoing amendment is respectfully requested pursuant to 37 C.F.R. §1.116. It is believed that the foregoing amendment adds no new matter to the present application.

### **Response to §102(b) Rejections**

Claims 1-14, 27, 28, 31-35, 37-41, 43-47, and 49 presently stand rejected under 35 U.S.C. §102(b) as allegedly being anticipated by *Ross* (U.S. Patent No. 5,444,444). It is stated in the outstanding Office Action that the "Ross patent [5,444,444] has been published more than a year of the US filing date of the present application. Therefore, the rejection under 102 should have been a 102(b) rejection instead of a 102(e) rejection." However, Applicant submits that the present application claims priority under 35 U.S.C. §120 to U.S. Patent Application No. 08/434,049, U.S. Patent Application No. 08/432,898, U.S. Patent Application No. 08/432,666, and U.S. Patent No.

5,400,020, which were all filed before August 22, 1995 (*i.e.*, the publication date of *Ross*).

Furthermore, Applicant submits that the aforementioned patent and patent applications describe the subject matter in *Ross* that is relied on by the Office Action to reject the present invention, as claimed.

In this regard, it is stated in the Office Action that:

Ross '444 discloses an apparatus and method of notifying a recipient of an unscheduled delivery. The vehicle is equipped with a satellite receiver, a controller and a communicator. The position of the vehicle is determined based on positioning data or signals. The controller compares the current vehicle location or position to the location in the mapped are. The communicator then communicates with the user to notify user. As shown in figure 1, there are provided controllers (10 and 21), a video screens or computer displays (14 and 26). As described in column 2, a time interval (timing information) and distance (distance information) are computed. Ross discloses the time period, and the predetermined distance as well as the telephone interface or communication. Also, a message or notification is forwarded to user via a telephone associated therewith. See column 6. As explained, more specifically in the claim section, Ross discloses a voice generator for generating or producing n audible message to notify the party.

Applicant submits that each of the foregoing features allegedly shown by *Ross* is described in U.S.

Patent Application No. 08/434,049, U.S. Patent Application No. 08/432,898, U.S. Patent

Application No. 08/432,666, and/or U.S. Patent No. 5,400,020. Therefore, Applicant asserts that

*Ross* is an improper prior art reference under 35 U.S.C. §102(b) and that the rejections under 35

U.S.C. §102(b) should be withdrawn.

In addition, Applicant asserts that the 35 U.S.C. §102(b) rejections constitute a new grounds of rejection and, therefore, objects to the issuance of a final rejection pursuant to M.P.E.P.

§706.07(a).

### **Response to §102(e) Rejections**

“(T)he fact that an application has named a different inventive entity than a patent does not necessarily make that patent prior art.” *Applied Materials Inc. v. Gemini Research Corp.*, 15 U.S.P.Q.2d 1816, 1818 (Fed. Cir. 1988). “(A)n applicant’s own work, even though publicly disclosed prior to his application, may not be used against him as a reference, absent the existence of a time bar to his application.” *In re DeBaun*, 214 U.S.P.Q. 933, 935 (C.C.P.A. 1982). Therefore, an applicant may overcome a rejection based on a patent “by showing that the patent disclosure is a description of applicant’s own previous work. Such a showing can be made by proving that the patentee was associated with applicant (*e.g.* worked for the same company) and learned of applicant’s invention from applicant.” M.P.E.P. §2136.05; see, also, *In re Mathews*, 161 U.S.P.Q. 276 (C.C.P.A. 1969).

### **Claims 1-14, 27, 28, 31-35, 37-41, 43-47, and 49**

Claims 1-14, 27, 28, 31-35, 37-41, 43-47, and 49 presently stand rejected under 35 U.S.C. §102(e) as allegedly being anticipated by *Ross* (U.S. Patent No. 5,648,770) and, in the alternative, *Ross* (U.S. Patent No. 5,444,444). However, Applicant submits that the subject matter disclosed by *Ross* (U.S. Patent Nos. 5,648,770 and 5,444,444) and used by the Office Action to reject pending claims 1-14, 27, 28, 31-35, 37-41, 43-47, and 49 is the product of Applicant’s own previous work. Therefore, the filing date of *Ross* is not “before the invention,” as defined by the pending claims of the present application, within the meaning of 35 U.S.C. §102(e). Consequently, *Ross* is not a valid reference under 35 U.S.C. §102(e), and the rejections to pending claims 1-14, 27, 28, 31-35, 37-41, 43-47, and 49 should be withdrawn.

It is stated in the outstanding Office Action that (a) “*if the patent has an earlier US effective filing date than the (present) application, such patent is considered prior art*” and (b) the law set forth in *In re DeBaun* “*only applies to the same applicant for the patent and the application.*” (The law at issue by *In re DeBaun* is that “an applicant’s own work, even though publicly disclosed prior to his application, may not be used against him as a reference, absent the existence of a time bar.”) However, Applicant respectfully traverses these statements in the outstanding Office Action and asserts that *Ross* is not a valid prior art reference.

In the case of *In re Mathews*, Dewey filed a patent application for a time delay protective device for an electronic circuit. 161 U.S.P.Q. 276 (C.C.P.A. 1969). The patent application (which issued as U.S. Patent No. 3,105,920) included unclaimed subject matter derived from Mathews, who was a co-worker of Dewey. Later, Mathews filed a patent application pertaining to the unclaimed subject matter disclosed in the earlier filed Dewey patent. The Court found that the Dewey patent included a “*full disclosure of the invention now claimed by Mathews.*” *Id.* at 277. Because the subject matter derived by Mathews was not claimed in the Dewey patent, Mathews was not named as an inventor in the Dewey patent. However, the Court held that the Dewey patent could not be applied as a prior art reference against the Mathews application, “since Dewey derived his knowledge (of the relevant subject matter) from Mathews.” *Id.* at 278. Therefore, the Dewey patent was not considered to be a prior art reference to the Mathews patent application even though: (a) the Dewey patent was filed before the effective filing date of the Mathews patent application, and (b) Mathews was *not* an inventor in the Dewey patent (*i.e.*, the Dewey patent and the Mathews patent application properly named different inventive entities). Accordingly, there is no requirement that an applicant must establish that he is a named inventor of a prior patent to remove the patent as a prior art reference via an affidavit/declaration under 37 C.F.R. §1.132.

In fact, M.P.E.P. §2136.05 states that “(w)hen a prior U.S. patent is not a statutory bar, a 35 U.S.C. 102(e) rejection can be overcome by antedating the filing date of the U.S. patent under 37 C.F.R. §1.131 or by submitting an affidavit or declaration under 37 C.F.R. §1.132 establishing that the relevant disclosure is applicant’s own work.” (Emphasis added). There is no requirement in M.P.E.P. §2136.05 for the applicant to be named as an inventor in the prior U.S. patent.

Furthermore, the Court of Customs and Patent Appeals has stated in the case of *In re Land and Rogers* that:

there are two conditions expressed in section 102(e): (1) the application for the reference patent must have been by one who is legally “another” and (2) the filing date must be “before the invention \* \* \* by the applicant \* \* \*.” When the 102(e) reference patentee got knowledge of the applicant’s invention from him, as by being associated with him, \* \* \* and *thereafter* describes it, he necessarily files the application *after* the applicant’s invention date and the patent as a “reference” does not evidence that the invention, when made, was already known to others. (Footnote omitted.) Evidence of such a state of facts, whatever its form, must be considered. 151 U.S.P.Q. 621, 633 (1966); see, also, *Mathews* at 279.

Noting that there is no mention of a requirement in *Land* for an applicant to be named as an inventor in a prior patent to overcome the prior patent as a reference, Applicant submits that the arguments in the Office Action incorrectly focus on the “by another” requirement of 35 U.S.C. §102(e) instead of the “before the invention” requirement. In focusing on the “before the invention” requirement, the “proper subject of inquiry” is “*who* invented the subject matter disclosed by (the reference) which was relied on to support the rejection.” *Id.* at 633 n. 11; see, also, *DeBaun* at 935. In other words, the proper inquiry is not who first disclosed the subject matter but rather who invented the subject matter. Consequently, to overcome a prior art reference under 35 U.S.C. §102(e), all that needs to be shown (in the absence of a time bar) is that the subject matter relied on by the Examiner to reject the applicant’s patent application was derived from the applicant.

In the present application, the Applicant has set forth sufficient facts (in the exhibits submitted along with the First Response on February 2, 1999) showing that he was the sole inventor of the subject matter in *Ross* used to reject the present invention, as claimed. Because the Examiner has not contested the adequacy of the exhibits in the First Response, Applicant assumes that the showing is sufficient. If the Examiner contests the sufficiency of the exhibits as a new issue, Applicant reserves the right to provide more evidence in support of Applicant's position. Since the foregoing exhibits show that the relevant subject matter in *Ross* was derived from the Applicant, the 35 U.S.C. §102(e) rejections under *Ross* are improper, pursuant to M.P.E.P. §2136.05, *In re Mathews*, and *In re Land*.

It is further alleged in the Office Action that in order for an affidavit under 37 C.F.R. §1.132 to overcome a previously filed reference, the affidavit "must meet the requirements of MPEP §715.01(a), §715.01(c), and §716.10." However, Applicant traverses this conclusion and asserts that the foregoing sections of the M.P.E.P. set forth situations when an applicant *may* overcome a prior patent or publication. There is no requirement that the facts of any particular case must meet one of the scenarios set forth by the aforementioned sections of the M.P.E.P. in order to overcome a reference via a 37 C.F.R. §1.132 affidavit/declaration. Moreover, Applicant has established that the requirements of M.P.E.P. §2136.05, *In re Mathews*, and *In re Land* have been satisfied for the facts of the present case and that *Ross*, therefore, should not be used as a prior art reference under 35 U.S.C. §102(e).

## Response to §103 Rejections

### Claims 36, 42, and 48

Claims 36, 42, and 48 presently stand rejected under 35 U.S.C. §103 as purportedly being obvious to *Ross* (U.S. Patent No. 5,648,770), and in the alternative, *Ross* (U.S. Patent No. 5,444,444). However, for the same reasons set forth hereinabove in the arguments for allowance of pending claims 1-14, 27, 28, 31-35, 37-41, 43-47, and 49, Applicant submits that the subject matter disclosed by *Ross* (U.S. Patent Nos. 5,648,770 and 5,444,444) and used to reject pending claims 36, 42, and 48 of the present invention constitutes Applicant's own prior work. Therefore, *Ross* (U.S. Patent No. 5,648,770) and *Ross* (U.S. Patent No. 5,444,444) are not valid prior art references, and the rejection to pending claims 36, 42, and 48 should be withdrawn.

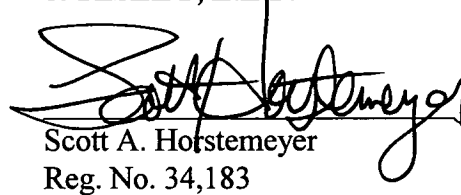
**CONCLUSION**

Applicant respectfully requests that all outstanding objections and rejections be withdrawn and that this application and all presently pending claims be allowed to issue. If the Examiner has any questions or comments regarding Applicant's response, the Examiner is encouraged to telephone Applicant's undersigned counsel.

Respectfully submitted ,

**THOMAS, KAYDEN, HORSTEMEYER  
& RISLEY, L.L.P.**

By:

  
Scott A. Horstemeyer  
Reg. No. 34,183

100 Galleria Parkway, N.W.  
Suite 1500  
Atlanta, Georgia 30339  
(770) 933-9500

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